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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,265	03/05/2002	Mark Alan Bilansky	AUS920020087US1	6432

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Duke W. Yee  
Carstens, Yee & Cahoon, LLP  
P.O. Box 802334  
Dallas, TX 75380

EXAMINER
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GEREZGIHER, YEMANE M

ART UNIT	PAPER NUMBER
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2144

DATE MAILED: 02/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/091,265	BILANSKY ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Yemane M. Gerezgiher	2144	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 November 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Response to Amendment***

1. The response received on 11/09/2005 has been entered. Claims 2 is cancelled and claims 1 and 3-34 remain pending in this application.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 and 3-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zorber (U.S. Patent Number 5,951,636) in view of Ross (WO 200242860 A).

As per claim 1, Zorber disclosed: retrieving header information for electronic messages on the post office protocol 3 server to form retrieved header information; [Abstract, Fig. 5, step 182, Col. 2, Lines 34-35, Col. 9, Lines 45-58 and Col. 10, Lines 1-10] presenting a mail list on a display using the retrieved header information and the attribute file; [Fig. 5, Steps 184-188, Col. 2, Lines 35-37] and responsive to a selection of an electronic mail message from the mail list, retrieving the electronic mail message from the post office protocol 3

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server and presenting the electronic mail message. [Fig. 5, Steps 190-202, Col. 2, Lines 38-45, Col. 6, Lines 39-67, Col. 9, Lines 45-58 and Col. 10, Lines 30-33, Col. 11, Lines 33-37, Col. 10, Lines 64-67, Zorber disclosed retrieving e-mail messages from POP3 server].

Zorber disclosed the invention as claimed. Further, although it has been widely known that an attribute file indicating the status (read, unread, flagged and so forth) of an electronic message (e-mail) in a mailing system and particularly in many client e-mail application, Zorber was silent about “updating an attribute file, wherein the attribute file includes an indication of whether an electronic mail message has been read;” However, as evidenced by the teachings of Ross, it was commonly known in the art to update a file indicating status of an electronic mail and synchronizing such updates throughout the mailing system in a POP3 mail application (see Page 22, Lines 1-19 and Page 9, Lines 12-17).

Thus, it is respectfully submitted that it would have been obvious to one of ordinary skill in the art at the time the invention was made to make use of such a functional feature of keeping the attribute file indicating the status of an electronic mail as evidenced by the teachings of Ross and have modified the teachings of Zorber in order to facilitate management of messages in electronic messaging system.

**The already combined teachings of Ross and Zorber** substantially disclosed the invention as claimed. However, the combined teachings was silent about configuring the POP3 server **not to delete the electronic mail message when the electronic mail message is retrieved** and that the attribute file distinguishing between electronic mail messages previously represented in the mail list and new electronic mail messages represented in the mail list.

Examiner respectfully submits that it was commonly known to enable an option to **“Leave a copy of the message on the server (POP3 server)”**. Even if POP3 server is originally and intentionally designed to delete an electronic mail by default once the electronic mail is retrieved/downloaded by a client mail application such as outlook ® in order to free a space at the server, the option **“not to delete”** the message on the POP server was commonly known. For example, as early as the introduction of the client mail application by Microsoft ® Outlook ® 2000 and 2002, **an option to leave a copy of the retrieved mail on the POP server** has been available (For instance, please see the attached documents retrieved from the WEB entitled: “IMAP serves next generation of e-mail”, published on 08/01/1996 and an article entitled: “OL2002: Outlook Downloads Messages from a POP3 server Twice”, published on 04/20/2001 and see RFC 2449, Page 10). Furthermore, as evidently admitted by the inventive entity (see applicant’s specification on page, 18, Lines 19-31, also disclosed below), it was known to distinguish between electronic mail messages

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previously represented in the mail list and new electronic mail messages represented in the mail list.

*The use of mail attribute file 718 allows for a "read/unread" indicator to be displayed in mail list 708 and an unread mail count that can be displayed along with the mail list 708. In addition, the stored UID values are used to **recognize the arrival of more recent messages than those that are already represented in the mail list and therefore in the mail attribute file. This allows the setting of a "New Mail" indicator, such as an LED or special icon. This information is readily available in the IMAP protocol from the server, but not with POP3** because each new connection to the server appears to be retrieving "new" mail (Specification, Page, 18, Lines 19-31).*

Thus, it is respectfully submitted that it would have been obvious to one of ordinary skill in the art at the time the invention was made to take the very well known features of IMAP4 server as also correctly admitted by the inventive entity and have modified the already combined teachings of Ross and Zorber to not delete the retrieved electronic message from the POP3 server in order to enable a client to further access the message from any other location using plurality of client e-mail applications and increase flexibility in managing the electronic messages.

As per claims 3 and 20, electronic mail message is retrieved from a cache on the data processing system (Col. 4, Lines 56-63 and Col. 10, Lines 15-24, Zorber disclosed retrieving e-mail message from a cache).

As per claims 4 and 21, wherein the step of retrieving the header information retrieves only the header information from the post office protocol 3 server (Col. 10, Lines 1-24, Zorber disclosed retrieving only the header information).

As per claims 5 and 22, Zorber disclosed: retrieving the header information comprises retrieving all parts of the electronic message from the post office protocol 3 server (Col. 9, Lines 60-64).

As per Claims 16, 18 and 33, theses claims have substantially similar limitations as claim 1 above, therefore, they are rejected with the same rationale. Further, since the already combined teachings of Zorber and Ross are performed in a computer system, a communication unit and a memory unit connected to a bus system, the memory having therein a set of instructions and a processing unit executing the instructions to perform the functional limitations was inherently disclosed. See Zorber's Col. 5, Lines 27-35 and Ross's Abstract, describing a computer program, method and a system carrying out the invention as claimed.

As per claims 6-9 and 23-26, with respect to the rejection applied to claims 1 and 18, above, the already combined teachings of Ross and Zorber substantially disclosed the invention as claimed. Furthermore, Zorber disclosed that the electronic message comprising attachments (Zorber Col. 7, Lines 52-65). However, failed to teach filtering a message to selectively save attachment from an e-mail message or along with the message, and failed to teach the filtering step comparing size and type of the attachment.

However, as evidenced by the teachings of Ross on page 15, Lines 18-23, allowing the user to selectively save an attachment from an e-mail message and further perform plurality of functions based on the user's desire to and from an e-mail message, the filtering step comparing the size and type of the attachment before saving the attachment was known in the art at the time the invention was made. See Ross on Page 10, Lines 13-20. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to take the teachings of Ross related to filtering an electronic mail and have modified the teachings of modified the teachings of Zorber in order to limit and control the size of the e-mail messages and attachments (page 10, Lines 18-20).

As per claim 10, Zerber disclosed: retrieving portions of incoming mail in storage in a mail inbox at the post office protocol 3 server, wherein the incoming mail is kept in storage in the mail box at the post office protocol 3



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server (Abstract, Fig. 5, step 182, Col. 2, Lines 34-35, Col. 9, Lines 45-58 and Col. 10, Lines 1-10, Zerber disclosed retrieving headers of e-mail messages at a POP3 server); presenting a mail list using the portions of incoming mail retrieved from the mailbox at the post office protocol 3 server (Fig. 5, Steps 184-188, Col. 2, Lines 35-37, Zerber disclosed presenting the retrieved headers in a form of a list selectable by the end users); retrieving, from the post office protocol 3 server, individual messages from the mail inbox at the post office protocol 3 server if one of the users selects a message for display (Fig. 5, Steps 190-202, Col. 2, Lines 38-45, Col. 9, Lines 45-58 and Col. 10, Lines 30-33);

Zerber substantially disclosed the invention as claimed. However, Zerber was silent about “filtering the message from the individual messages to a folder in a shared directory in the local storage in response to a user request to save the message, wherein the shared directory is shared by each user sharing the mail account.”

An artisan now working with the teachings of Zerber would have been motivated to look for teachings that may have allowed further improvements on the art of electronic mail process. In these arts, Ross taught a multi-user shared e-mail system on a single computer allowing each users to share and access the email system having therein plurality of folders for storing received e-mails (Abstract) and further taught an incoming mail filters (Page 5, Lines 7) enabling multiple users to access a single shared computer to send, receive

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and store messages (Page 7, Lines 11-13) in a in file folders created by each users in the shared e-mail system (as recited in claims 14 AND 31, Page 8, Lines 9-13, Page 9, Lines 12-17, Page 11, Lines 3-8, Page 15, Lines 18-23 and Page 21, Line 24 through Page 25, Line12).

Thus, it is respectfully submitted that it would have been obvious to one of ordinary skill in the art at the time the invention was made to take the teachings of Ross related to filtering messages to save in different user defined folders in the shared environment and have modified the teachings of Zerber related to e-mail processing system in order to provide access to various users in a production or operational environment with out access to an individual computer to share and access their e-mail optimizing the cost associated with resources. Page 4, Lines 24-28.

**The already combined teachings of Ross and Zorber substantially disclosed the invention as claimed. However, the combined teachings were silent about configuring the POP3 server not to delete the electronic mail message when the electronic mail message is retrieved. Examiner respectfully submits that it was commonly known to enable an option to “Leave a copy of the message on the server (POP3 server”. Even if POP3 server is originally and intentionally designed to delete an electronic mail by default once the electronic mail is retrieved/downloaded by a client mail application such as outlook ® in order to free a space at the server, the option**

**“not to delete”** the message on the POP server was commonly known. For example, as early as the introduction of the client mail application by Microsoft® Outlook® 2000 and 2002, **an option to leave a copy of the retrieved mail on the POP server** has been available (For instance, please see the attached documents retrieved from the WEB entitled: “IMAP serves next generation of e-mail”, published on 08/01/1996 and an article entitled: “OL2002: Outlook Downloads Messages from a POP3 server Twice”, published on 04/20/2001 and furthermore see RFC 2449, Page 10)).

Thus, it is respectfully submitted that it would have been obvious to one of ordinary skill in the art having no restriction or shortage of a storage at the POP3 server at the time the invention was made to take the very well known optional feature of “not to delete the copy of the retrieved message at the server” and have modified the already combined teachings of Ross and Zorber in order to enable a client to further access the message from any other location using plurality of client e-mail applications.

Claims 17, 27 and 34, have substantially similar limitations as claim 10 above and they are rejected with the same rationale. Further, since the already combined teachings of Zorber and Ross are performed in a computer system, a communication unit and a memory unit connected to a bus system, the memory having therein a set of instructions and a processing unit executing the instructions to perform the functional limitations was inherently disclosed.

See also Zorber's Col. 5, Lines 27-35 and Ross's Abstract for all embodiments of the invention as combined.

As per claims 11 and 28, Zorber disclosed the invention as claimed. Further, although it has been widely known that an attribute/bookkeeping file indicating the status (read, unread, flagged and so forth) of an electronic message (e-mail) in a mailing system and particularly in many client e-mail application, Zorber was silent about creating a bookkeeping file indicating which messages have been viewed and which messages have been deleted and synchronizing/resyncing the bookkeeping file at a computing device every time mail/e-mail is accessed therein.

However, as evidenced by the teachings of Ross, it was commonly known in the art to update a file indicating status of an electronic mail and synchronizing such updates throughout the mailing system in a POP3 mail application (see Page 22, Lines 1-19 and Page 9, Lines 12-17).

Thus, it is respectfully submitted that it would have been obvious to one of ordinary skill in the art at the time the invention was made to make use of such a functional feature of keeping the attribute file indicating the status of an electronic mail as evidenced by the teachings of Ross and have modified the teachings of Zorber in order to facilitate management of messages in electronic messaging system.

As per claims 12 and 29, with respect to the rejection applied to claims 10 and 27, above, the already combined teachings of Ross and Zorber substantially disclosed the invention as claimed. Furthermore, Zorber disclosed that the electronic message comprising attachments (Zorber Col. 7, Lines 52-65). However, failed to teach filtering a message to selectively save attachment from an e-mail message or along with the message, and failed to teach the filtering step comparing size and type of the attachment.

However, as evidenced by the teachings of Ross on page 15, Lines 18-23, allowing the user to selectively save an attachment from an e-mail message and further perform plurality of functions based on the user's desire to and from an e-mail message, the filtering step comparing the size and type of the attachment before saving the attachment was known in the art at the time the invention was made. See Ross on Page 10, Lines 13-20. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to take the teachings of Ross related to filtering an electronic mail and have modified the teachings of modified the teachings of Zorber in order to limit and control the size of the e-mail messages and attachments (page 10, Lines 18-20).

As per claims 13 and 30, Zerber disclosed, retrieving message headers from the post office protocol 3 server upon connection of the at least one computing device to the post office protocol 3 server; and displaying a list of the

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message headers at the at least one computing device (see Zerber Abstract, Fig. 5, step 182, Col. 2, Lines 34-35, Col. 9, Lines 45-58, Col. 10, Lines 1-10, Fig. 5, Steps 184-188, Col. 2, Lines 35-37).

As per claim 19, electronic mail message is retrieved from the post office protocol 3 server (Col. 9, Lines 45-58 and Col. 11, Lines 33-37, Col. 10, Lines 64-67, Zorber disclosed retrieving e-mail messages from POP3 server).

As per claims 15 and 32, wherein the incoming mail is kept in the storage at the post office protocol 3 server using a configurable option for the post office protocol 3 client (see Zerber Col. 6, Lines 43-66, Zerber disclosed a user viewing messages (in-box) stored remotely on the post office system, providing the functionality of IMAP4 (storing messages at the server). Furthermore, it was commonly known feature to provide a configurable option to allow users to leave (save) a copy of the e-mail messages on the server such as POP3 server. For example, Microsoft outlook 2000 ® provides such an option when configuring the POP3 server).

### ***Response to Arguments***

2. Applicant's arguments filed 11/09/2005 have been fully considered but they are not persuasive.

3. The inventive entity argue that Zerber does not teach or suggest managing and retrieving e-mail messages from a POP3 server, where the e-mail

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messages are not deleted from the POP3 when the e-mail message is retrieved (Applicant's Remark Page 13 of 21, Lines 1-6, Page 15 of 21, Lines 21-24)

- The examiner respectfully disagrees with that contention. Zerber indeed disclosed managing/retrieving electronic mail messages from a POP3 server. See Abstract, "This disclosed system is especially suited for "offline" type protocols, such as POP3". Further in the abstract, Zerber disclosed communicating with the server to delete the already retrieved/downloaded electronic message from the storage at the server. See also Zerber Fig. 2, Column 2, Lines 62-64 and Column 5, Lines 16-17. As far as the limitation of not deleting the retrieved mail message from the server is concerned, the examiner points to the rejection applied above to claim 1. It was known in the art at the time the invention was made to optionally configure a POP3 server to retain a copy of a message after downloading of the message. See the rejection above and the attached documents indicating such a functional limitation.

Furthermore, assuming **Arguendo**, that the option to leave a copy of the retrieved electronic mail ("not to delete") was not known in the art. The teachings of Zerber disclosed instructing the POP3 server to delete after retrieving the desired electronic mail message from the server. This act is usually performed to optimize storage at the

server, meaning once locally downloaded at the client terminal; client e-mail application instruct the server to kill the copy stored at the server since it is already downloaded by the e-mail client application. Now having that said, if the additional limitation of deleting the message once retrieved is **omitted**, the remaining limitation of Zerber meets the claimed limitation ("electronic mail message is not deleted from the server", as recited in the claims). Thus, the claimed limitation would have been obvious to one of ordinary skill in the art at the time the invention was made to omit such undesired feature since it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involving only routine skill in the art. *In re Karlson*, 136 USPQ 184.

4. The inventive entity further argues that the examiner's conclusion of obviousness is based upon improper hindsight reasoning (see Applicant's Remark, Page 18 of 21, Lines 1-7.

- In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge



which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper.

See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

5. Finally, the inventive entity argues that Ross does not teach filtering a message from individual messages in to a folder in a shared directory (see Applicant's Remark, Page 20 of 21, Lines 27-31).

- The examiner once again disagrees with that allegation. Ross does teach filtering a message from individual messages in to a folder in a shared directory. As also recited above in the rejection of claim 10, Ross taught a multi-user shared e-mail system on a single computer allowing each users to share and access the email system having therein plurality of folders for storing received e-mails (Abstract) and further taught an incoming mail filters (Page 5, Lines 7) enabling multiple users to access a single shared computer to send, receive and store messages (Page 7, Lines 11-13) in a in file folders created by each users in the shared e-mail system (as recited in claims 14 AND 31, Page 8, Lines 9-13, Page 9, Lines 12-17, Page 11, Lines 3-8, Page 15, Lines 18-23 and Page 21, Line 24 through Page 25, Line12).

Thus, the applied prior art of record does remain proper and the examiner maintains his position accordingly.

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

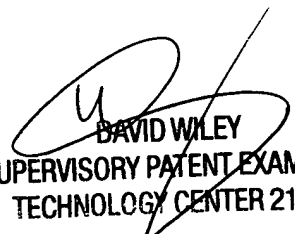
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yemane M. Gerezgiher whose telephone number is (571) 272-3927. The examiner can normally be reached on 9:00 AM - 6:00 PM Mon - Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached at (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Yemane M. Gerezgiher*  
*Patent Examiner, Computer Science*

  
DAVID WILEY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100